

65-205  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
08/199,070	02/22/94	MARASCO	43471

00B1/0022

DAVID G. CONLIN  
DIKE, BRONSTEIN, ROBERTS & CUSHMAN  
130 WATER ST.  
BOSTON, MA 02109-4280

0000

DATE MAILED:

03/22/94

### NOTICE TO FILE MISSING PARTS OF APPLICATION FILING DATE GRANTED

An Application Number and Filing Date have been assigned to this application. However, the items indicated below are missing. The required items and fees identified below must be timely submitted **ALONG WITH THE PAYMENT OF A SURCHARGE** for items 1 and 3-6 only of \$\_\_\_\_\_ for large entities or \$\_\_\_\_\_ for small entities who have filed a verified statement claiming such status. The surcharge is set forth in 37 CFR 1.16(e).

If all required items on this form are filed within the period set below, the total amount owed by applicant as a ☐ large entity, ☐ small entity (verified statement filed), is \$\_\_\_\_\_.

Applicant is given **ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE** of this application, **WHICHEVER IS LATER**, within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- ☐ The statutory basic filing fee is: ☐ missing ☐ insufficient. Applicant as a ☐ large entity ☐ small entity, must submit \$\_\_\_\_\_ to complete the basic filing fee.
- ☐ Additional claim fees of \$\_\_\_\_\_ as a ☐ large entity, ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
- ☐ The oath or declaration:  
☐ is missing.  
☐ does not cover items omitted at time of execution.

An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date is required.

- ☐ The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- ☒ The signature to the oath or declaration is: ☒ missing; ☐ a reproduction; ☐ by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- ☐ The signature of the following joint inventor(s) is missing from the oath or declaration:  
\_\_\_\_\_  
An oath or declaration listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.
- ☐ The application was filed in a language other than English. Applicant must file a verified English translation of the application and a fee of \$\_\_\_\_\_ under 37 CFR 1.17(k), unless this fee has already been paid.
- ☐ A \$\_\_\_\_\_ processing fee is required for returned checks. (37 CFR 1.21(m)).
- ☐ Your filing receipt was mailed in error because check was returned without payment.
- ☒ The application does not comply with the Sequence Rules. See attached Notice to Comply with Sequence Rules 37 CFR 1.821-1.825.  
070 AS 06/08/94 08199070
- ☐ Other 06/08/94 08199070

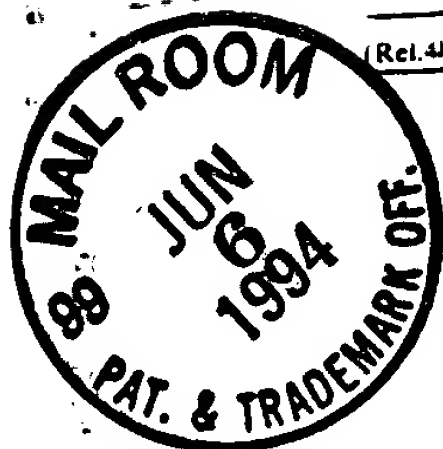
Direct the response and any questions about this notice to  
Division, Special Processing and Correspondence Branch (703) 308-1202.

**A copy of this notice MUST be returned with the response.**

BEST AVAILABLE COPY

110-115

#3



(Rev. 4-5-91 Pub. 605)

FORM 5-1

5-3

0380

3/22/94

Docket No. 43471

RECEIVED

JUN 08 1994

PATENT APPLICATION DIVISION

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: W. Marasco, et al.

Serial No.: 0 8 / 199,070

Group No.:

Filed: 2/22/94

Examiner:

For: Nucleic Acid Delivery System, Method of Synthesis And Uses Thereof

Commissioner of Patents and Trademarks

Washington, D.C. 20231

ATTENTION: Application Division

## COMPLETION OF FILING REQUIREMENTS

(check and complete this item, if applicable)

- I. ☒ This replies to the Notice to File Missing Parts of Application (PTO-1533) mailed March 22, 1994

NOTE: If these papers are filed before the office letter issues adequate identification of the original papers should be made, e.g., in addition to the name of the inventor and title of invention, the filing date based on the "Express Mail" procedure, the serial number from the return post card or the attorney's docket number added.

- ☒ A copy of the Notice to File Missing Parts of Application—Filing Date Granted (Form PTO-1533) is enclosed.

NOTE: The PTO requires that a copy of Form PTO-1533 be returned with the response to the notice to file missing parts to the application.

## DECLARATION OR OATH

- II. ☒ An unexecuted ~~No original~~ declaration or oath was filed and enclosed is the <sup>executed</sup> ~~original~~ declaration or oath for this application.

## CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Adele E. Stone

(Type or print name of person mailing paper)

Date:

May 19, 1994

(Signature of person mailing paper)

Adele E. Stone

070 AS 06/08/94 08199070

1 115 110.00 CK  
(Completion of Filing Requirements [5-1]—page 1 of 5)

OR

- ☐ The original declaration or oath which was filed was determined to be defective.  
A new original oath or declaration is attached.

**NOTE:** 37 CFR 1.41(a) points out that "Full names must be stated, including the family name and at least one given name without abbreviation together with any other given name or initial."

**NOTE:** For surcharge fee for filing declaration after filing date complete item VI(3) below.

**NOTE:** Acceptable minimums in the declaration for identification of the specification to which it applies are the name of the inventor and (1) serial number (2) attorney docket number which was on the application as filed and the filing date (3) title of the invention and filing date (4) title of invention and reference to a specification which is attached to the declaration at the time of execution and filed with the declaration or (5) title of invention and a statement by a registered attorney that the application filed in the PTO is the application which the inventor executed by signing the declaration. If identification (4) is used it must be accompanied by a statement that the "attached" specification is a copy of the specification and any amendments thereto which were filed in the PTO to obtain the filing date; such a statement must be a verified statement if made by a person not registered to practice before the PTO. Notice of September 12, 1983 (1035 O.G. 3).

**NOTE:** Another minimum found acceptable in the declaration is the filing date (i.e., date of express mail) and the express mail number, useful where the serial number is not yet known. But note the practice where the express mail deposit is a Saturday, Sunday or holiday within the District of Columbia. 37 CFR 1.10(c).

(complete (c) or (d), if applicable)

Attached is a

- (c) ☐ Statement by a registered attorney that the application filed in the PTO is the application which the inventor executed by signing the declaration.
- (d) ☐ Statement that the "attached" specification is a copy of the specification and any amendments thereto which were filed in the PTO to obtain the filing date.

#### AMENDMENT CANCELLING CLAIMS

III. ☐ Cancel claims \_\_\_\_\_ inclusive.

#### TRANSMITTAL OF ENGLISH TRANSLATION OF NON-ENGLISH LANGUAGE PAPERS

IV.

- ☐ Submitted herewith is a verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO.

**NOTE:** For fee processing a non-English application complete item VI(5) below.

**NOTE:** A non-English oath or declaration in the form provided or approved by the PTO need not be translated. 37 CFR 1.69(b).

**NOTE:** The translation for a regular application filed in a foreign language must be verified. 37 CFR 1.52(d).

#### SMALL ENTITY STATUS

V.

- ☒ A verified statement that this filing is by a small entity

**NOTE:** If an original verified statement and a refund request is filed within two months of the date of payment of a fee then the excess fee paid will be refunded on request. 37 CFR 1.28(a).

(Completion of Filing Requirements [5-1]—page 2 of 5)

6. ☐ fee for processing and retention of application  
(37 CFR 1.21(l) and 1.53(d)—\$300.00) \$\_\_\_\_\_

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(d) and this, as well as, the changes to 37 CFR 1.53 and 1.78 indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee or the processing and retention fee of § 1.21(1) within 1 year of notification under § 1.53(d) must be paid.

Total completion fees

\$ 420.00

### EXTENSION OF TIME

VII.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

- (a) ☒ Applicant petitions for an extension of time, the fees for which are set out in 37 CFR 1.17(a)-(d), for the total number of months checked below:

<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input checked="" type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 360.00	\$180.00
<input type="checkbox"/> three months	\$ 840.00	\$420.00
<input type="checkbox"/> four months	\$1,320.00	\$660.00

Fee \$ 110.00

If an additional extension of time is required please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 110.00

or

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

### TOTAL FEE DUE

VIII.

The total fee due is

Completion fee(s) \$ 420.00

Extension fee (if any) \$ 110.00

TOTAL FEE DUE \$ 530.00

(Completion of Filing Requirements [5-1]—page 4 of 5)

(check and complete applicable items)

- ☒ is attached  
☐ a separate refund request accompanies this paper  
☐ was filed on \_\_\_\_\_ (original)

### COMPLETION FEES

#### VI.

**WARNING:** Failure to submit the surcharge fees where required will cause the application to become abandoned. 37 CFR 1.53(d).

**NOTE:** The filing fees, fees for claims and surcharge fees listed below in items 1, 2 and 3 are reduced by 50% where proof of a small entity status is established on or before the date the fee is paid. If the full fee was paid but a verified statement is filed within 2 months of the date of timely payment of a fee then the excess fee paid will be refunded on request. 37 CFR 1.28(a).

1. Filing fee

- ☒ original patent application (37 CFR 1.16(a))—\$710.00;  
Small entity—\$355.00 \$ 355.00  
☐ design application (37 CFR 1.16(f))—\$290.00; small  
entity—\$145.00 \$ \_\_\_\_\_  
\$ \_\_\_\_\_

2. fees for claims

- ☐ each independent claim in excess of 3 (37 CFR  
1.16(b))—\$74.00; small entity—\$37.00 \$ \_\_\_\_\_  
☐ each claim in excess of 10 (37 CFR 1.16(c))—\$22.00;  
small entity—\$11.00 \$ \_\_\_\_\_  
☐ multiple dependent claim(s) (37 CFR 1.16(d))—\$230.00;  
small entity—\$115.00 \$ \_\_\_\_\_

3. surcharge fees

- ☒ late payment of filing fee

and/or

- ☒ late filing of original declaration or oath (37 CFR  
1.16(e))—\$130.00; small entity—\$65.00; \$ 65.00

**NOTE:** Even where a facsimile declaration or oath signed by the inventor(s) was part of the originally filed papers the surcharge fee is required.

**NOTE:** If both the filing fee and declaration or oath were missing from the original papers only one surcharge fee for both need be paid. 37 CFR 1.16(e).

4. ☐ petition and fee for filing by other than all the inven-  
tors  
or a person not the inventor  
(37 CFR 1.17(h) and 1.47—\$130.00) \$ \_\_\_\_\_  
5. ☐ fee for processing an application filed with a speci-  
fication in a non-English language (37 CFR 1.17(k)  
and 1.52(d))—\$130.00 \$ \_\_\_\_\_

PAYMENT OF FEES

IX.

- ☒ enclosed is a check in the amount of \$ 530.00  
☐ charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_  
A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).

AUTHORIZATION TO CHARGE ADDITIONAL FEES

X.

WARNING: Accurately count claims, especially multiple dependant claims, to avoid unexpected high charges if extra claims are authorized.

- ☒ The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the pendency of this application to Account No. 04-1105

☒ 37 CFR 1.16 (a), (f) or (g) (filing fees)

☒ 37 CFR 1.16 (b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

☐ 37 CFR 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

☒ 37 CFR 1.17 (application processing fees)

WARNING: While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under § 1.136(a) this authorization should be made only with the knowledge that: "Submission of the appropriate extension fee under 37 CFR 1.136(a) is to no avail unless a request or petition for extension is filed." (Emphasis added). Notice of November 5, 1985 (1060 O.G. 27).

☐ 37 CFR 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b))

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying . . . issue fee". From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

Reg. No. 30,628

Tel. No.: (617) 523-3400

  
SIGNATURE OF ATTORNEY

Ronald I. Eisenstein

Type or print name of attorney

Dike, Bronstein, Roberts & Cushman

P.O. Address

130 Water Street

Boston, MA 02109

Docket No. 43471



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: W. Marasco, et al.

Serial No.: 08 199,070

Group No.:

Filed: 2/22/94

Examiner:

For: Nucleic Acid Delivery System, Method of Synthesis and Uses Thereof  
Box SequenceCommissioner of Patents and Trademarks  
Washington, D.C. 20231SUBMISSION OF "SEQUENCE LISTING," COMPUTER READABLE COPY, AND/OR  
AMENDMENT PERTAINING THERETO FOR BIOTECHNOLOGY INVENTION  
CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCE

(check and complete this item, if applicable)

- 1.
- ☒
- This replies to the Office Letter dated
- March 22, 1994

NOTE: If these papers are filed before the office letter issues adequate identification of the original papers should be made, e.g., in addition to the name of the inventor and title of invention, the filing date based on the "Express Mail" procedure, the serial number from the return post card or the attorney's docket number added.

- ☒
- A copy of the Office Letter is enclosed.

## IDENTIFICATION OF DECLARANT

2. I
- Ronald L. Eisenstein
- 
- (Type or print name of declarant signing below)

state the following:

## CERTIFICATION OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

(check and complete appropriate item below):

☒ 37 CFR 1.8(a)  
with sufficient postage  
as first class mail

or

☐ 37 CFR 1.10  
as "Express Mail Post Office  
to Addressee" Mailing Label  
No.Adele E. Stone

(Type or print name of person mailing paper)

Date May 19, 1994Adele E. Stone  
(Signature of person mailing paper)



## ITEMS BEING SUBMITTED

3. Submitted herewith is/are

*(check each item as applicable)*

- A. ☒ "Sequence Listing(s)" for the nucleotide and/or amino acid sequence(s) in this application, each "Sequence Listing" is assigned a separate identifier as required in 37 CFR § 1.821(c) and 37 CFR §§ 1.822 and 1.823
- B. ☐ An amendment to the description and/or claims wherein reference is made to the sequence by use of the assigned identifier as required in 37 CFR § 1.821(d)
- C. ☒ A copy of **each** "Sequence Listing" submitted for this application in computer readable form in accordance with the requirements of 37 CFR §§ 1.821(e) and 1.824
- D. ☐ Please transfer to this application, in accordance with 37 CFR § 1.821(e), the computer readable copy(ies) from applicant's **other** application identified as follows:

In re application of:

Serial No.: 0 /

Group No.:

Filed:

Examiner:

For:

The Computer readable form(s) of applicant's other application corresponds to the "Sequence Identifier(s)" of the application as follows:

**Computer Readable Form**

**"Sequence Identifier"**

(other application)

(this application)

**NOTE:** "If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application. The new application shall be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified." 37 CFR 1.821(e).

(Submission—nucleotide and/or amino acid sequence [9-37]—page 2 of 5)



- E. ☒ A statement that the content of **each** "Sequence Listing" submitted and **each** computer readable copy are the same as required in 37 CFR § 1.821(g).
- ☐ Since the statement is **not** made by a person registered to practice before the Office the Statement is verified as required in 37 CFR § 1.821(b)
- F. ☒ Since this submission is made in fulfilling the requirement under 37 CFR § 1.821(g), a statement that the submission includes no new matter
- ☐ Since the statement is **not** made by a person registered to practice before the Office the statement is verified as required in 37 CFR § 1.821(g)

**STATEMENT THAT "SEQUENCE LISTING" AND COMPUTER READABLE COPY ARE THE SAME AND/OR THAT PAPERS SUBMITTED INCLUDES NO NEW MATTER**

4. I hereby state:

*(complete applicable item A and/or B)*

- A. ☒ Each computer readable form submitted in this application, including those forms requested to be transferred from applicant's other application, is the same as the "Sequence Listing" to which it is indicated to relate
- B. ☐ All papers accompanying this submission, or for which a request for transfer from applicants' other application, introduce no new matter

**VERIFICATION**

5. **NOTE:** "Such a statement must be verified statement if made by a person not registered to practice before the Office." 37 CFR § 1.821(f) and (g).

☐ I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true: and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**STATUS**

6. Applicant is
- ☒ a small entity—verified statement:
- ☒ attached.
- ☐ already filed.
- ☐ other than a small entity.

## EXTENSION OF TERM

7. **NOTE:** "Extension of Time in Patent Cases (Supplement Amendments)—If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

**NOTE:** See 37 CFR 1.645 for extensions of time in interference proceedings and 37 CFR 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply

(complete (a) or (b) as applicable)

- (a) ☒ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input checked="" type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 350.00	\$175.00
<input type="checkbox"/> three months	\$ 810.00	\$405.00
<input type="checkbox"/> four months	\$ 1,280.00	\$640.00
	<b>Fee</b>	<b>\$ 110.00</b>

If an additional extension of time is required please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 110.00

OR

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

## FEE PAYMENT

8. ☒ Attached is a check in the sum of \$ 110.00 (included with completion of filing requirements attached herewith).  
☐ Charge Account No. \_\_\_\_\_ the sum of \$\_\_\_\_\_.

A duplicate of this transmittal is attached.

(Submission—nucleotide and/or amino acid sequence [9-37]—page 4 of 5)

## FEE DEFICIENCY

9. *NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.*
10. ☒ If any additional extension and/or fee is required, charge Account No. 04-1105.

## SIGNATURE(s)

Ronald I. Eisenstein

Type or print name of person signing declaration

Signature

Date

Dike, Bronstein, Roberts & Cushman

P.O. Address of Signatory

130 Water StreetBoston, MA 02109Tel. No.: (617) 523-3400Reg. No. 30,628

(if applicable)

☐ Inventor☐ Assignee of complete interest☐ Person authorized to sign on behalf of assignee☒ Attorney or agent of record☐ Filed under Rule 34(a)☐ Other \_\_\_\_\_

(Specify identity of declarant)

(Complete the following if applicable)

Type name of assignee \_\_\_\_\_

Address of assignee \_\_\_\_\_

Title of person authorized to sign on behalf of assignee \_\_\_\_\_

Assignment recorded in PTO on \_\_\_\_\_

Reel \_\_\_\_\_ Frame \_\_\_\_\_

(If the person signing above is not an attorney registered to practice before the Office complete the following)

Reg. No. \_\_\_\_\_

Tel. No.: ( ) \_\_\_\_\_

SIGNATURE OF ATTORNEY \_\_\_\_\_

Type or print name of attorney \_\_\_\_\_

P.O. Address \_\_\_\_\_